

REMARKS:

Applicants express gratitude to the Examiner for the withdrawal of the 112, second paragraph rejection, parts A and B, the 103(a) rejection over Cauwenberg et al. and Van der Puy et al., and the 112, first paragraph rejection relating to the lack of written description rejection on pages 5 to top half of page 6 of the previous Office Action.

Applicants respectfully request reconsideration and withdrawal of the outstanding Office Action rejections based on the foregoing amendment and following remarks. Claim 9 has been amended only to better define the claimed embodiment of the invention. Applicants believe that no new search is required, thus its entry is requested. No new matter is added.

Rejections under 35 U.S.C. §112

Claims 9 and 10 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner asserts that “an amount necessary to change the color of said saponified solution from a darker color to a lighter color” is unclear because this amount is not specified in the claim. Applicants submit that the amount of oxidizing agent used to change the color of the solution depends on factors such as temperature, reaction time, or the amount of impurities in the solution as detailed on page 8, lines 13-22 of the specification. Therefore, because the amount of oxidizing agent to be used depends on such diverse factors, claim 9 has been amended to recite a clear and definite functional definition of the amount of oxidizing agent to be added. Applicants submit that claim 9, as amended, is now definite because it would be clear to one of ordinary skill to add oxidizing agent until the color of the solution changes from a darker color to a lighter color. Applicants respectfully request withdrawal of the rejection of claim 9 under §112. The rejection of claim 10, depending from claim 9, should also be withdrawn for at least the above reason.

Claims 1-49 have been rejected under 35 U.S.C. §112, first paragraph, as lacking enablement. The Examiner asserts that Applicants did not address the argument that lack of enablement exists because of the absence of any working example where the structures of the diester used and the diacid produced are specified, there is no evidence that

oxidizing agents other than H_2O_2 work in the claimed invention because yields for the use of sodium hypochlorite or calcium hypochlorite were not cited in the declaration, and the absence of any working examples where 2-(2-imidazolin-2-yl)nicotinic acids are produced. Applicants respectfully disagree.

Applicants refer to the arguments on page 12 of the previous response based on Example 1 and the disclosure on page 9, lines 28-29 and page 10, line 8 as well as the structural details on page 4, flow diagram I of the specification. It is obvious that the saponification mixture of crude diester in Example 1 is identical to the saponification mixture of the pyridine-2,3-diester according to the invention, e.g. based on page 9, lines 28-29 or page 10, line 7. The specification also lists structural details of the pyridine-2,3-diester on page 4 in flow diagram I (right structure). Independent claims 1, 16, and 33 were previously amended to incorporate the specific structure of pyridine-2,3-dicarboxylic acid ester disclosed on page 4 of the specification.

With regard to the examples provided in the declaration, Applicants submit that these examples do indeed show that oxidizing agents other than H_2O_2 work in the claimed method because in each example using these other oxidizing agents, the color of the reaction solution changed from black to a light amber color. The determination of the product yields is not recited in the method steps and does not belong in the invention. Applicants point out that the claims do not recite a method of manufacturing pyridine-2,3-dicarboxylic acid, but rather the claims refer to an in-situ method of purification of a saponified solution of the pyridine-2,3-dicarboxylic acid. The change in color of the saponified solution from a dark color to a light color is the hallmark of this purification. Thus, Applicants submit that the examples provided in the declaration are clearly enabling to one of skill in the art to practice the presently claimed method for the in-situ removal of impurities from a saponified solution of a pyridine-2,3-dicarboxylic acid ester.

With regard to the absence of working examples where 2-(2-imidazolin-2-yl)nicotinic acids are produced, there is disclosure on page 11, lines 17-30 of the specification that pyridine-2,3-dicarboxylic acid is well known in the art as an intermediate in the preparation of 2-(2-imidazolin-2-yl)nicotinic acids, esters, and salts. Prior art references (U.S. patent Nos. 4,658,030 and 4,782,157) disclosing methods of preparing 2-(2-imidazolin-2-yl)nicotinic acids from pyridine-2,3-dicarboxylic acid have been incorporated by reference.

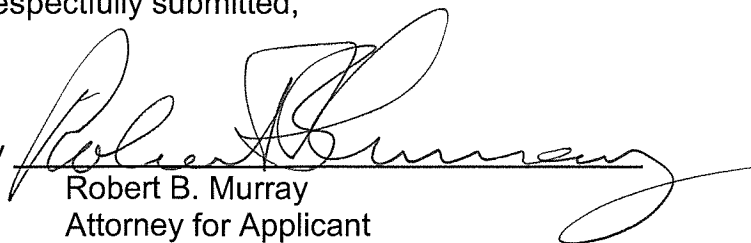
Further, the steps for the production of 2-(2-imidazolin-2-yl)nicotinic acids from a pyridine-2,3-dicarboxylic acid are recited in claim 33. The specification provides a written description of the method for removing impurities from pyridine-2,3-dicarboxylic acid and the method for using pyridine-2,3-dicarboxylic acid to prepare 2-(2-imidazolin-2-yl)nicotinic acids has been incorporated by reference. Applicants submit that the disclosure clearly enables one of skill in the art and it is not necessary to provide a working example in which 2-(2-imidazolin-2-yl)nicotinic acids are produced. Moreover, the details of these conversion steps are not essential for the invention. However, if it would satisfy the enablement requirement, Applicants propose explicitly incorporating the subject matter of the above references into the specification to recite the methods of producing 2-(2-imidazolin-2-yl)nicotinic acids. The Examiner's comments on this proposal are solicited.

Conclusion

In view of the above remarks and claim amendment, Applicants believe that the rejections set forth in the October 9, 2008 Office Action have been fully overcome and that the present claims fully satisfy the patent statutes. Applicants therefore believe that the application is in condition for allowance. The Examiner is invited to telephone the undersigned if it is deemed to expedite allowance of the application. No new matter has been added.

Respectfully submitted,

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